

Serial No.: 10/776,876
Group Art Unit No.: 1624

REMARKS

Claims 1-20 are pending. Allegedly claims 6-12 and 15 have been withdrawn from consideration. Claims 1-5, 13, 14 and 16-20 have been rejected.

Applicants ask that the examiner reconsider his objections to claims 6-12 and 15 in light of the following:

Applicants would like to note that it appears the examiner has overlooked the preliminary amendments filed 11 February 2004 as part of the package of papers comprising the filing of a divisional case of USSN 10/030,661, and giving rise to the case under examination here. A copy of that preliminary amendment is enclosed. Also, the examiner is referred to the Image File Wrapper for the captioned application on the Public PAIR website which shows a first and second set of "claims". The file marked "claims" furthest down in the list on PAIR is the preliminary amendment filed on 11 February, 2004. The file marked "claims" above that lower one is a copy of the native claims as they existed in the PCT application, but which the applicants intended to amend via the preliminary amendment of 11 February 2004. Apparently the latter was added to the record as it was scanned into the IFW and there is no notation to the effect that it was not entered into the record for purposes of determining patentability. Accordingly, applicants believe the examiner, after reviewing the 11 February amendment, may elect to hold that claims 6 – 12 and 15 are properly presented and the patentability of each can be treated on the merits.

Applicants request that the amendments presented herein above be entered into the record.

Rejection under 35 USC 112 ¶2

Claims 1-5, 13 and 16-20 have been rejected on several bases. Applicants traverse these rejections and respond as follows:

a) Claim 1 has been rejected on the basis that R¹ recites an indefinite phrase, namely: "or, as a single substituent, optionally in combination with a further substituent as hereinbefore defined..." Applicants deleted this phrase herein above.

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b) Further in claim 1, the examiner has objected to parts of R⁹ and R¹⁰, namely: “aryl, e.g., phenyl, or aralkyl, e.g. benzyl, for instance morpholine or piperizine...” Applicants have amended claim 1 by deleting these words.

c) In another instance in claim 1, the examiner has questioned the use of “such as CH₂OH from serine” in the definition of R¹². Applicants have deleted this terminology as part of the amendments made to claim 1 herein.

d) Claim 5 is objected to as lacking an antecedent basis for “oxo”. That term has been added to the definition of R¹ in claim 1. There are bases for it in the specification at example 23, 44, 45, 46. And the term was in the claims as of the priority dates claimed, as part of claim 4 in the form of “2-oxo-pyrimid-5-ylmethyl”.

e) Claim 13 is said to be indefinite because it refers to certain examples in the specification, rather than reciting specific subject matter. This claim is deleted herein.

f) Claim 16 is said to be a duplicate of claim 1 because its intended use is recited as “for use in therapy”. It is deleted herein.

g) As regards claim 18, it is deleted herein, thus rendering moot the examiner’s objection based on the perception that claiming a mechanism of action is indefinite. Applicants do note there are many mechanism of action claims have been issued by the USPTO going back many years.

h) Claims 2-5 and 16-20 have been rejected as depending on native claim 1 and thus carrying over the indefiniteness of that claim. Because claim 1 is being amended herein in ways that would appear to address the examiner’s discomfort with the definiteness of claim 1, these claims 2-5 and 16-20 should also now enjoy the benefit of the amendments to claim 1 in regards to definiteness.

i) Claim 17 is being deleted herewith, so the objection to it based on “use” is rendered moot.

Rejection under 35 USC §101

Claim 17 has been rejected on the basis it does not meet the statutory requirements for patentable subject matter as set out in §101. This claim is being deleted herewith.

Rejection under 35 USC 112 ¶1

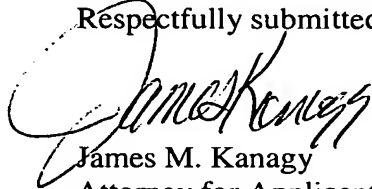
Claim 18 has been objected to on the basis of undue breadth. Allegedly, the phrase: “activity of the enzyme Lp-PLA2” is not enabled by the disclosure in the specification

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lacking enablement of every disease state associated with inhibiting the activity of L_p -PLA₂. Applicants respectfully point out that it is a well-recognized scientific principle that where one inhibits an enzyme, one must necessarily treat any malady associated with the abnormal activity of that enzyme. Because applicants have chosen to re-cast the claims in the case to focus on a single compound in this particular application, they are electing to delete claim 18 and re-present this claim in a limited form directed to the use of these compounds for treating a single disease, one of many that flows from inhibiting the L_p -PLA₂ enzyme. Applicants do not concede the examiner's point of lack of enablement is meritorious. Administering a compound of formula I will have the effect of treating any disease now known, or discovered later, where inhibition of the L_p -PLA₂ enzyme prevents the onset of that disease, modulates its severity, or treats and/or cures it.

In view of the above remarks, reconsideration of this application is requested. Should the Examiner have any questions or wish to discuss any aspect of this case, the Examiner is encouraged to call the undersigned agent at the number below.

Respectfully submitted,



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